

Application No.: 10/623,958
Date of Response: 09/02/2004
Reply to Action of: 08/20/2004

REMARKS

The applicant respectfully traverses the Examiner's restriction requirement of August 20, 2004, and respectfully requests reconsideration thereof. The applicant notes that the elected species appears in both sets of generic claims. It is unclear how the Examiner determined that two separate and distinct inventions are being claimed, as no reasoning was presented. The applicant now makes a good faith effort to reply to the Examiner's Office action, despite his disagreement with the restriction.

The applicant respectfully submits that Claim 1 is a generic claim, with claims 2-10 and 19 dependent thereupon being species of the genus defined in claim 1. Likewise, claim 11 is a generic claim, with claims 12-18 and 20 dependent thereupon being species of the genus defined in claim 11.

MPEP § 806.04(d), Definition of a Generic Claim, reads as follows:

In general, a generic claim should include no material element additional to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species. For the purpose of obtaining claims to more than one species in the same case, the generic claim cannot include limitations not present in each of the added species claims. Otherwise stated, the claims to the species which can be included in a case in addition to a single species must contain all the limitations of the generic claim.

The applicant notes that the alleged species is explicitly recited in both dependent claim 5 (which falls under generic claim 1) and dependent claim 14 (which falls under generic claim 11). Clearly both generic claims read on the elected species. The Examiner has acknowledged that "Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional

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species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141."

It is respectfully submitted that all of the alleged Species 2 identified by the Examiner in the Office Communication of August 20, 2004 are comprehended by
5 the limitations of claims 1 and 11 as supported by the specification and drawings.

37 CFR 1.142(a). Requirement for restriction, reads as follows:

Two or more independent and distinct inventions may not be claimed in one national application except that more than one species of an invention, not to exceed
10 a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent
15 form (§ 1.75) or otherwise include all the limitations of the generic claim.

It is respectfully submitted that claims 1 – 20 of the instant application fall within the scope of 37 CFR 1.142(a). It is further respectfully submitted that the number of species claimed is a reasonable number, and that the Examiner has
20 not offered reasons to the contrary, such that the multiplicity of species would require an unduly extensive and burdensome search.

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MPEP § 808, Reasons for Insisting Upon Restriction, indicates that a second aspect of a requirement to restrict is to provide "(B) the reasons for insisting upon restriction therebetween as set forth in the following sections." Subsequently, MPEP § 808.02 Related Inventions, reads as follows:

- 5 Where the related inventions as claimed are shown to
be distinct under the criteria of MPEP § 806.05(c) –
§806.05(i), the examiner, in order to establish reasons
for insisting upon restriction, must show by
appropriate explanation one of the following:
- 10 (A) Separate classification thereof;...
- (B) A separate status in the art when they are
 classifiable together:...
- (C) A different field of search.

15 It is respectfully submitted that the Examiner has not properly set forth the
restriction requirement, and in particular, has not established reasons for insisting
upon restriction, such as that an unduly extensive and burdensome search is
required. It is further respectfully submitted that none of the criteria A, B, or C of
MPEP § 808.02 are applicable to claims 1 – 20 of the applicants' case.

20 Accordingly, reconsideration of the Examiner's restriction requirement is
respectfully requested, and examination of claims 1 – 20 of the instant
application is also respectfully requested. If the Examiner disagrees with the
applicant and wishes to clarify his position, the Examiner is respectfully invited to
contact applicant's agent.


25 Applicants respectfully request reconsideration and that a timely Notice of
Allowance be issued in this case. If, for any reason, the Patent Examiner
believes that a telephone conference with applicants' agent might in any way
facilitate the prosecution of this case, the Examiner is respectfully requested to
call such agent.

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To the extend necessary, please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-2753 and credit any excess fees to such deposit account. If necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby
5 made.

Respectfully submitted,
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By 

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